



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,990	02/07/2007	Joachim Bruchlos	DE920030057US1	6932
46320 7590 09/14/2010 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 2022 BOCA RATON, FL 33487				
EXAMINER				
STRODER, CARRIE A				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
09/14/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,990

Applicant(s)

BRUCHLOS ET AL.

Examiner

CARRIE A. STRODER

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 21, 28 and 35-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 21, 28 and 35-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on 23 July 2010, wherein:

Claims 14, 21, 28, and 35-53 are currently pending;
claims 1-13, 15-20, 22-27, and 29-34 are cancelled; and
claims 14, 21, and 35 are currently amended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 14, 21, 28, 40, 46, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Dan et al. (US 6148290).**

Referring to claims 14 and 28:

Dan teaches

creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration preferably includes storing of a service contract identification number, information regarding the service contract and the service contract itself.");

including said contract data into a request for said service (col. 7, line 24 thru col. 8, lines 20; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling actual runtime invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

issuing, via the network, said request for said service (col. 7, line 24 thru col. 8, lines 20 and abstract; "In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is

acceptable from the specific requester as per the rules of interaction..."); and

receiving, via the network the service according to said selection (col. 7, line 24 thru col. 8, lines 20 and abstract; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is executed to provide this service, a response may be generated").

Referring to claim 21:

Dan teaches

at least one processor, wherein the at least one processor configured for (col. 7, lines 24-47; "server" and where a server inherently includes a processor):

creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, lines 24-47; "This registration preferably includes storing of a service contract identification number, information regarding the service contract and the service contract itself.");

including said contract data into a request for said service (col. 7, line 24 thru col. 8, lines 20; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling actual runtime

invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

issuing said request for said service (col. 7, line 24 thru col. 8, lines 20; "In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction..."); and

receiving the service according to said selection (col. 7, line 24 thru col. 8, lines 20; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is

executed to provide this service, a response may be generated.").

Referring to claims 40, 46, and 52:

Dan teaches wherein multiple contract selection parameters are combined in a single service request (col. 7, line 24 thru col. 8, line 20; "The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service..." and where "rules" indicates the combination of multiple contract selection parameters in a single service request).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 36, 42, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290).**

Referring to claims 36, 42, and 48:

Dan teaches wherein said contract data is processed via software interfaces adapted to comprise said contract data, said

interfaces comprising respective definitions of the protocol in use (col. 6, lines 38-61; "The client/requester logic implementation 528 executing in the client engine 516, makes its service requests via an interface 530 which is a standard programming interface identifying the types of requests for service which can be made for the service provided by the application 500...For example, enforcement code 512, upon receiving a request to be sent from the application 526, can log the request (noting time and content), number the request for correlation to an anticipated response, provide a signing function, include a timer function and notification in event of timeout and pass the request by a chosen protocol." and where it would have been obvious to a person having ordinary skill in the art at the time of the invention to include the protocols and ports required to communicate since communication takes place).

Dan does not teach where said interfaces comprise respective definitions of the transport protocol in use, of the messaging protocol in use, and on an associated port type in use. However, Examiner takes Official Notice that various transport protocols, messaging protocols, and port types were old and well known at the time of the invention (else, why would the invention need to specify the ones in use?) and therefore, it would have been obvious to a person having ordinary skill in

the art at the time of invention, to define the protocols and port types which would be provided by the service provider because then it would be clear to all parties concerned, exactly what protocols and ports would be supported by the service provider.

Further, claim limitations that employ phrases of the type "adapted to," "capable of," or "for" doing something are typical of claim limitations which may not distinguish over prior art. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to do so.

3. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290), in view of Reid et al. (US 20020178120).

Referring to claim 35:

Dan teaches
receiving, via the network, said contract data included in a request with which the service is requested, wherein said contract data comprises contract selection parameters for selecting at least one service contract out of said plurality of contracts (col. 7, line 24 thru col. 8, lines 20 and abstract; "...in step 720, the contract enforcement code is generated and integrated with the service implementation code for enabling

actual runtime invocation. FIG. 8 illustrates the use of the contract enforcement code during runtime, according to an embodiment of the present invention. In step 800, an external request (or message, or document) arrives at a particular enforcement code component. The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

evaluating said contract selection parameters (col. 7, line 24 thru col. 8, lines 20; "The contract enforcement code then determines, based on the incorporated rules of interaction, the current interaction state and the interaction history of the service (e.g., requests and responses received), and whether such a request (or message, or document) is acceptable from the specific requester as per the rules of interaction...");

providing, via the network, the service according to said contract (col. 7, line 24 thru col. 8, lines 20 and abstract; "...the contract enforcement code invokes, in step 820, an appropriate application method (or program). After the appropriate service implementation logic is executed to provide this service, a response may be generated.").

Dan discloses a service contract system for providing a service over a network. Dan does not explicitly disclose selecting one particular contract according to said evaluation and further selection logic.

However, Reid teaches a similar system for managing contracts. Reid teaches selecting one particular contract according to said evaluation and further selection logic (paragraph 35; "...allows a user to search for agreements based on several fields including but not limited to: agreement number...").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the system disclosed in Dan to incorporate selecting one particular contract according to said evaluation and further selection logic as taught by Reid because this would provide a manner for selecting the desired contract from among a plurality of contracts thus aiding the client by providing the proper contract.

4. Claims 37-39, 43-45, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290), in view of "SOAP Version 1.2 part 1: Messaging Framework", W3C, 2 October 2001 (hereinafter referred to as "SOAP").

Referring to claims 37, 43, and 49:

Dan does not teach; however, SOAP teaches wherein said contract data is processed within header fields of a web service request (Section 4.2.1).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Dan as taught by SOAP because this would allow for the exchange of information in a decentralized, distributed environment (see Abstract of SOAP reference).

Referring to claims 38, 44, and 50:

Dan does not teach; however, SOAP teaches wherein said contract data is processed as a part of the endpoint specification of a respective service request (Section 4.2.3).

Referring to claims 39, 45, and 51:

Dan does not teach; however, SOAP teaches wherein said contract selection parameters are transported in a SOAP message conforming to the SOAP standard (Section 1; "SOAP version 1.2 provides a simple and lightweight mechanism for exchanging structured and typed information between peers in a decentralized, distributed environment using XML").

5. **Claims 41, 47, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 6148290), in view of Lamb et al. (US 20050198111).**

Referring to claims 41, 47, and 52:

Dan does not teach; however, Lamb teaches wherein said contract selection parameters comprise meta-data identifying a particular contract (paragraph 96; "A format output bundle activity 1526 will hold all conditioned events for a determined amount of time, sort them by date, and bundle all of the conditioned event objects by contract clause ID and add any metadata needed to identify the bundle." implies that metadata may be used to identify a contract).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Dan as taught by Lamb because this would assist in identifying the appropriate contract.

Response to Arguments

Applicant's arguments filed 23 July 2010 have been fully considered but they are not persuasive.

Applicant argues that Dan does not teach "creating said contract data comprising contract selection parameters for selecting at least one service contract out of said plurality of contracts." Examiner respectfully disagrees. Specifically, applicant argues that the "parameters identified by Examiner are not used 'for selecting at least one contract out of said plurality of contracts' as claimed." Thus, applicant seems to be interpreting the claim as requiring selecting a contract.

However, this is not required by the language of the claim. The claim's positive limitation is that contract data is being created. The part of the claim which states, "for selecting at least one service contract out of said plurality of contracts," is merely describing the contract data. It is not a positive claim limitation. Nowhere does the applicant state that any actual selecting of a contract takes place.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689